

REMARKS/ARGUMENTS

The non-final Office Action dated 3/4/2005 withdrew claims 1-13 and 16-25 pursuant to a restriction requirement. Claims 14 and 26 were examined on the merits. A provisional double patenting rejection was entered; allowable subject matter was suggested; and proposed claim amendments were set forth. By this Amendment, claims 1-13 are cancelled; claim 14 is amended; claims 15-25 are cancelled; and new claims 27-30 are presented.

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow previously submitted claims 14 and 26, as well as newly submitted claims 27 – 30.

Turning now to the Detailed Action, the following remarks are set forth and responded to in the same order as presented in the Office Action.

New Claims 27-30

In light of the Official Action in the companion application no. 10/613,754, applicants' attorney has taken the liberty of expanding the claims of this application to include the other compounds that were not originally elected, but were searched in the companion application and kindly included in the scope of the search. The Official Action of 3/10/2005 in the 10/6134,754 stated, "The prior art does not teach or suggest, alone or in combination, a combination comprising the modulating sequence of EPOR and a compound of any of formulae (1) – (4)." It is, therefore, believed that all of the compounds disclosed in the subject application should be allowable as presently claimed as a method for forming the complex that is the combination referred to by the Examiner. The Examiner is respectfully requested to enter the new claims and consider them on their merits.

Election/Restriction

So far as the restriction requirement, applicants accept the restriction requirement and all of the claims are directed to elected Group II, “a method for modulating the activity of EPO-R.” This is recited in the preamble of new claim 27; the remaining claims depend from claim 27. This method was held to be a separate invention from the claims elected in the companion application. In the companion application, 10/613,754, all of the disclosed compounds (recited in claim 27) were searched and were included in the action on the merits. It is believed that such an approach is appropriate in this application.

Specification

The date of the reference has been corrected by amendments to the specification.

Double Patenting

The provisional double patenting rejection over claims 1-3, 33 and 35 of the above-referenced 10/613,754 application is not understood. These claims recite a certain “combination comprising a polypeptide...and a non-peptide organic molecule....” An amendment in that case will be submitted shortly.

A restriction requirement is believed to be a defense to a rejection for double patenting. Since the claims to Group II were elected for this application and the claims for Group I were elected for the companion application, it would seem that a rejection for double patenting is inappropriate and inconsistent with the restriction requirement. The only claims of the companion application that might be asserted to be relevant to a double patenting rejection are claims 29 to 32, but these claims are also substantially different from the claims of the subject application. Of course, all of the claims of both applications are directed to the subject compounds acting in conjunction with the EPOR. However, it was

the position in the restriction requirement that the claims were directed to different independent inventions and, as such, should not be subjected to a requirement of a terminal disclaimer. The Examiner is respectfully requested to explain how the section on double patenting is consistent with the earlier section on the Election/Restriction.

Allowable Subject Matter and Proposed Claim Amendments

The suggested modification of claim 14 has been adopted and used in all of the claims.

CONCLUSION

The Examiner's meticulous consideration of the application is appreciated. This invention is a very important asset of the subject assignee and the assignee wishes to ensure that any claims that are issued have been thoroughly considered.

In view of the above amendments and remarks, the Examiner is respectfully requested to withdraw the rejections and all the pending claims, subject to resolution of the double patenting rejections, and to allow claims 14 and 26-30. If the Examiner believes that the prosecution of the subject application may be expedited by a telephonic interview, the Examiner is hereby authorized to call Bertram Rowland collect at (650) 344-4674.

Finally, Applicants request that future correspondence be addressed to PETERS, VERNY, JONES, SCHMITT & ASTON, LLP, 425 Sherman Avenue, Suite 230, Palo Alto,

CA 94306 in view of the Power of Attorney and Change of Correspondence Address filed
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Respectfully submitted,

PETERS, VERNY, JONES,
SCHMITT, & ASTON, LLP

By David J. Aston
David J. Aston, Reg. No. 28,051
Tel.: (650) 324-1677
Fax: (650) 324-1678